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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,484	05/21/2001	Horst Grafe	HM-390PCT	5641
7590 Friedrich Kueffner 317 Madison Avenue New York, NY 10173				
EXAMINER				
PRONE, JASON D				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
11/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/744,484

Applicant(s)

GRAFE ET AL.

Examiner

Jason Daniel Prone

Art Unit

3724

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 9-11 are objected to because of the following informalities: the preambles should be replaced with "A device comprising". See 112 issues below.

Appropriate correction is required.

Specification

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. The specification incorporates all of the 112 errors listed below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9:

Claim 9 recites the limitation "the cutting" on line 1. There is insufficient antecedent basis for this limitation in the claim.

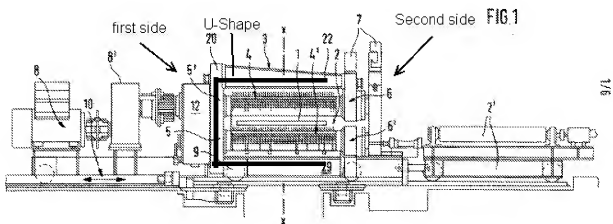
On line 4, the phrase "a rolling table" is unclear. Line 2 previously discloses the term "a rolling table". It is unclear if the "rolling table" of line 4 represents the same or different structure as the "rolling table" of line 2.

It is unclear what structure of the device (device being the tool as a whole) is the "shears" and what structure is the frame. Shears are labeled as item 3 but item 3 appears to be pointing at arm 22. Also, in the following paragraph the shears include additional structure not typically called shearing structure (i.e. drive apparatus). Using the typical definition of what one skilled in the art would consider shears to be, the shears should only be the cutting blade structure only. So the blade held by the blade holders would be what one skilled in the art would consider the shears. However, the description of Figure 1 in the specification calls the tool in the Figure "shears". Is the tool as a whole to be called "shears"? If this is the case, the preamble should be "A shears device comprising".

On lines 7-8, the phrase "shears arranged on the drive carriage, the shears including a drive apparatus and a U-shaped frame" is unclear. First, "the shears including a drive apparatus" is unclear. Using Figure 1, shears 3 are not remotely close to drive apparatus 8. How can item 8 be considered part of item 3? Next, "the shears 3 appear to be part of the U-shaped frame 20 not the other way around. Especially since shears 3 appears to be on arm 22 of the U-shaped frame. Finally, it would be the frame 20 not the shears 3 that is on the drive carriage 9 since shears 3 do not appear to be in communication with carriage 9.

On lines 8-9, the phrase "the frame having...a removable second side opposite the first side" is unclear. Using the Figure below, the U-shape frame appears to be items 20, 22, and 29. It is unclear what structure makes up the removable second side

of the frame. Basically it is clear what the second side of the frame would be but it is unclear what structure makes the second side removable.



On lines 8 and 10-11, the phrase “the frame having...an upper horizontal arm” is unclear. The frame is first disclosed as being U-shaped. Therefore the frame inherently discloses the structure allowing it to be U-shaped (vertical base and two horizontal arms). Now as claimed, the U-shaped frame has an upper horizontal arm in addition to the inherent U-shaped structure that would give the U-shaped frame 3 horizontal arms making the frame E-shaped.

On lines 11-14, the phrase “the shears further including holding element provided on the first side and the second side of the frame, and blade holders supported by the holding elements” is unclear. How can the holding elements be included as part of the shears structure when the holding elements are provided on the frame? The issue here appears to be what the base structure is. Using the Figure 1, it appears the frame incorporates two horizontal arms making the frame U-shaped; the arms have first

and second sides, holding elements on the first and second sides of the arms, blade holders supported by the holding elements and shears supported by the blade holders.

On lines 14-15, the phrase "wherein at least one of the holding elements on an end of the horizontal arm at the second side of the frame" is unclear. First it is unclear which horizontal arm is being referred to. Second, the claim discloses first and second sides which also happen to represent the ends of the horizontal arms. Therefore it is unclear what structure makes up "an end of the horizontal arm".

On lines 23-24, the phrase "force means for moving the clamping element together with the gliding plates" is inherent. If the clamping element has gliding plates then they both inherently move together since they are one in the same.

On line 26, the phrase "at least one holding element" is unclear. It is unclear which of the holding elements this phrase is referring to. If this limitation is supposed to be referencing the similar phrase on line 14, it should be amended to "the at least one of the holding elements".

On lines 25-27, the phrase "so that the clamping element and the at least one holding element generate a form-fit frictional coupling" is unclear. It is unclear what structure allows the clamp and the holding element to perform a "generating a coupling" function. Structure must be disclosed that allows one item to couple to another item.

Claims 10 and 11

Claims 10 and 11 feature the same errors or errors very similar to the errors listed in claim 9 above.

5. It is to be noted that claims 9-11 have not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

Response to Arguments

6. Applicant has attempted to link all of the structure together as requested in the previous Office action. Now the issue appears to be that it is unclear what structure the term "shears" represents. Is it the whole device or a portion of the device? Also, applicant is writing the claims in light of the specification which appears to have all of the same errors the examiner pointed out in the claims in this Office action and the last Office action. The examiner is requesting a substitute specification because the current state of the specification is very confusing.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Daniel Prone whose telephone number is (571)272-4513. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

04 November 2009

/Jason Daniel Prone/

Primary Examiner, Art Unit 3724